

Please enter the following amendments and remarks:

### **REMARKS**

Claims 1-8 have been withdrawn. Claims 14, 15, 17, 26, 27, 34, 40, 43, 45, 46, and 51 have been objected to due to informalities. Claims 13 and 14 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15-23, 25-42, and 47-50 have been rejected under 35 U.S.C. § 102(b), as being unpatentable over Atkins, GB 2,299,568 (“Atkins”). Claims 39-42, 48, and 49 have been rejected under 35 U.S.C. § 102(b), as being unpatentable over Holden-Banks, GB 2,311,273 (“Holden-Banks”). Claim 24 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Kaufmann, U.S. Patent No. 5,264,265 (“Kaufmann”). Claims 9-11, 13, and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Walter, U.S. Patent No. 5,591,290 (“Walter”) and Holden-Banks. Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Walter, and Holden-Banks, and further in view of Kaufmann. Claims 15-22, 24, and 26-81 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann. Claims 23, 25, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann, and further in view of Atkins. Claims 43-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann. Claim 50 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Atkins. Claim 47 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann and further in view of Atkins. Claim 51 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann and further in view of

Atkins Claims 43-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins as in view of Kaufmann. Applicant respectfully traverses these rejections for at least the following reasons.

**A. Claim Objections**

Claim 14 has been objected to because the phrase “wherein” was missing from the claim. *Office Action @ 2*. Applicant respectfully submits that Claim 14 as amended overcomes this objection.

Claims 15, 17, 26, 27, 34, 40, 43, 45, 46, and 51 have been objected to because these claims have “minor grammatical errors.” *Office Action @ 2*. Applicant respectfully submits that Claims 15, 17, 26, 27, 34, 40, 43, 45, 46, and 51 as amended overcome this objection.

**B. Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 13 and 14 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

35 U.S.C. § 112, second paragraph, recites:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention.

The present Office Action rejects Claim 13, specifically referencing the portion of the claim which states “said label portion.” The present Office Action represents that this phrase has

insufficient antecedent basis. *Office Action @ 2*. Applicant respectfully submits that Claim 13 as amended satisfies 35 U.S.C. § 112.

The present Office Action rejects Claim 14, specifically referencing the portion of the claim which states “the first portion” and “the second portion.” The present Office Action represents that this phrase has insufficient antecedent basis. *Office Action @ 2*. Applicant respectfully submits that Claim 14 as amended satisfies 35 U.S.C. § 112.

**C. Rejections under 35 U.S.C. § 102(b)**

Claims 15-23, 25-42, and 47-50 have been rejected under 35 U.S.C. § 102(b), as being anticipated by Atkins. Claims 39-42, 48, and 49 have been rejected under 35 U.S.C. § 102(b), as being anticipated by Holden-Banks. Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. § 102(b) recites:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

In addition, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See*, MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Rejection under 35 U.S.C. § 102 (b) based upon Atkins

The present Office Action has rejected Claims 15-23, 25-42, and 47-50 under 35 U.S.C. § 102(b), as being anticipated by Atkins. Applicant respectfully traverses these rejections for at least the following reasons.

Claim 15, recites in part, “printing indicia on at least one of a portion of said first surface and a portion of said second surface.” The present Office Action rejects this, in part, by reciting teachings of Atkins. Particularly, the Office Action at page 3 recites:

Label assemblies...may be manufactured using the following method... A sheet is printed on one or both sides, trimmed to shape, and then folded to form leaflet portion 6. Folded leaflets portion 6 are loaded into a hopper feed unit. The carrier labels...are formed from self-adhesive labels, which may be printed with additional information. A release coating...is applied to the top surface of the first end...of the carrier label..., and a strip of adhesive on the underside is de-sensitized or “killed”... The label...is then cut to shape, forming flap 11 and notches... Tear lines...are formed by means of a perforator. Any waste material around the carrier label...is stripped and a web of carrier labels is wound onto a reel.

Atkins, page 6, line 26 to page 7, line 5.

Atkins fails to teach printing indicia on at least one of a portion of said first surface and a portion of said second surface as recited in Claim 15. Because Atkins does not discuss printing on both surfaces of the label, Applicant respectfully submits that Atkins fails to teach each one of the elements of independent Claim 15.

Further, Atkins teaches the process of making a label assembly by attaching folded leaflets to a carrier label (page 6, line 26 to page 7, line 5). This fails to anticipate Applicant’s

invention because the process of attaching a leaflet to a carrier label does not teach Applicant's "printing indicia" in that attaching leaflets and printing are completely distinct operations.

Still further, Atkins teaches use of a "carrier label" where:

[t]he length of the carrier label...is chosen such that the second end...overlaps the first end...and the flap 11 adheres to the cover sheet. The flap 11 adheres to the leading edge of the cover sheet 28 and forms a permanent bond.

Atkins, page 5, lines 9-17 and Figure 5.

Claim 15 is distinct from the teaching of Atkins in that Applicant's invention teaches that the portion of the label which is longer than the periphery of the object may be printed on both surfaces. Instead Atkins teaches the use of an overlapping portion for permanent bonding and adhering purposes only. Thus, Applicant respectfully submits that Atkins fails to teach each element of independent Claim 15.

Similarly, Applicant respectfully submits that Atkins fails to teach each element of Claims 26, 33, and 39 at least for those reasons set forth with respect to Claim 15 above.

Further, Claim 39 recites, in part, "a first portion of the member is oriented at an oblique angle relative to a second portion." Atkins does not teach the use of an obliquely-oriented portion of a label member. Therefore, Claim 39 is not anticipated by Atkins at least because of the claim 39 recitation of an oblique angle.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 15, 26, 33, and 39. Further, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejections of Claims 16-23, 25, 27-32,

34-38, 40-42, and 47-50, as these claims ultimately depend on distinct, independent Claims 15, 26, 33, and 39.

Rejection under 35 U.S.C. § 102(b) based on Holden-Banks

The present Office Action has rejected Claims 39-42, 48, and 49 under 35 U.S.C. § 102(b), as being anticipated by Holden-Banks. Applicant respectfully traverses these rejections for at least the following reasons.

Claim 39 recites, in part, a first portion...oriented at an oblique angle relative to a second portion.” The present Office Action rejects this, in part, by reciting teachings of Holden-Banks. Particularly, the Office Action asserts that Holden-Banks discloses a label which “includes two portions...with...a portion of the label with the edge at an oblique angle...,” referring to Figures 2, 5, 11, and 12, Page 4 (lines 1-15), and Page 12 (lines 1-27) of Holden-Banks.

Holden-Banks fails to teach providing “a...member having...a first portion of the member...oriented at an oblique angle relative to a second portion” as recited in Claim 39. Holden-Banks discloses a label that is *straight* with two edges being of unequal length, giving rise to oblique *edges*. See, e.g., *Figures 11 and 12*. Applicant’s invention is distinct at least because Claim 39 discloses making a label having “a *first portion*...oriented at an oblique angle relative to a *second portion*...” (emphasis added). See Figure 18 of Application. Holden-Banks discloses obliquely oriented edges, which is not the same and is distinct from an obliquely oriented portion of a label, as recited in Claim 39.

In this regard, Applicant respectfully submits that Holden-Banks fails to teach each of the elements of independent Claim 39. Further, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection of Claims 40-42, 48, and 49, as these claims ultimately depend on the distinct, independent Claim 39.

**D. Rejections under 35 U.S.C. 103(a)**

Claim 24 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins (GB 2,299,568) in view of Kaufmann. Claims 9-11, 13, and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Walter and Holden-Banks. Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Walter and Holden-Banks, and further in view of Kaufmann. Claims 15-22, 24, and 26-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann. Claims 23, 25, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann, and further in view of Atkins. Claims 43-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann. Claim 50 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Atkins. Claim 47 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann as and further in view of Atkins. Claim 51 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann and further in view of Atkins. Claims 43-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Kaufmann. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Rejection under 35 U.S.C. § 103(a) based upon Atkins in view of Kaufmann

Claim 24 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Kaufmann. Applicant respectfully traverses this rejection for at least the following reasons.

For at least the reasons set forth hereinabove, Atkins fails to teach all of the limitations of independent Claim 15. This deficiency in the teaching of Atkins is not remedied by the addition of Kaufmann nor does the present Office Action suggest that it is. Kaufmann teaches forming a



peel-back label, but does not teach the use of a label whose length is longer than the object to be wrapped, wherein the portion longer than the perimeter of the object may be printed on both sides. Because Atkins and Kaufmann fail to disclose this feature, not all of the elements of Claim 15 are taught.

Accordingly, Applicant submits at least Claim 15 is patently distinguishable over the prior art cited. Applicant further submits that Claim 24 is similarly distinguishable over the prior art cited by virtue of its ultimate dependency from a patently distinct base Claim 15.

Rejection under 35 U.S.C. § 103(a) based upon Atkins in view of Walter and Holden-Banks

Claims 9-11, 13, and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkins in view of Walter and Holden-Banks. Applicant respectfully traverses these rejections for at least the following reasons.

Claim 9 recites “printing...inks or indicia on...surfaces of [a] substrate web,” wherein “pressure sensitive adhesive” is affixed to the substrate web. The present Office Action rejects this, in part, by reciting teachings of Atkins in view of Walter and Holden-Banks. Particularly, the Office Action asserts that Walter discloses a method of applying material onto the adhesive surface of a label (to de-sensitize it) and, then, reapplying release paper. The Office Action also asserts that Holden-Banks discloses the process of printing on an adhesive surface to form a label.

The present Office Action concedes that Atkins fails to teach the removal of release paper from adhesive, then printing a de-sensitized surface, and finally reapplication of release paper to

the adhesive. Walter does not remedy this shortfall in the teaching of Atkins for the process of printing on adhesive. While Holden-Banks discusses printing on adhesive (page 12, lines 1-3), Holden-Banks fails to disclose printing on *pressure sensitive* adhesive, as is recited in Claim 9. Since neither Holden-Banks, Atkins, nor Walter alone or in any combination, teach printing on pressure sensitive adhesive, not all elements in Claim 9 are taught.

This combination of references also fail to teach “reapplying said release paper to said pressure sensitive adhesive material” as claimed in Claim 9. The Office Action asserts that Walter discloses “reapplying” by citing to a section which states “layers” are “relaminated.” Walter col. 4, lines 20-23. However, Walter does not teach “reapplying” release paper because Walter teaches “relamination,” which encompasses distinct process steps compared to the process of “reapplication.” *See generally Walter*. Because neither Atkins nor Walter alone or in any combination teach reapplying release paper, not all elements in Claim 9 are taught.

Accordingly, Applicant respectfully submits that all elements of Claim 9 are patently distinguishable over Atkins in view of Walter and Holden-Banks. Thus, Applicant asserts no prima facie obviousness case against Claim 9 exists. Applicant further submits that Claims 10, 11, 13, and 14 are similarly distinguishable over the prior art of record by virtue of their ultimate dependency from a patently distinct base Claim 9.

Rejection under 35 U.S.C. § 103(a) under Holden-Banks in view of Kaufmann

Claims 15-22, 24, and 26-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Holden-Banks in view of Kaufmann. Applicant respectfully traverses this rejection for at least the following reasons.

Holden-Banks, in view of Kaufmann, fails to teach all of the elements of independent Claim 15. Claim 15, as amended, recites a “member having...a tab portion protruding...for facilitating re-attachment and...partial separation of said device.”

Applicant acknowledges, consistent with the present Office Action, that Holden-Banks is silent as to providing a tab on a label. *Office Action @ 10*. In filling this gap in the teaching of Holden-Banks, Figure 1 of Kaufmann reveals use of a tab, but Kaufmann teaches permanently bonding “the top ply...to the bottom ply in an area...which functions as a...tab.” Kaufmann, col. 2, lines 40-52. Applicant’s invention recites a tab in Claim 15 as not permanently bonded, but to allow for *separation* from the label. Because both Holden-Banks and Kaufmann fail to disclose the use of a tab that is not permanently bonded to the label which allows for separation from the label, not all elements of Claim 15 are taught.

Further, Figure 1 of Kaufmann reveals use of a tab, but Kaufmann discloses “[t]here is no...adhesive on the underside portion of the bottom ply functioning as part of the peel-tab...” Kaufmann, col. 2, lines 40-52. Applicant’s Claim 15 includes a tab having adhesive on its underside for “facilitating re-attachment.” Because both Holden-Banks and Kaufmann fail to disclose the use of a tab with adhesive, not all elements of Claim 15 are taught.

Holden-Banks, in view of Kaufmann, fails to teach all of the elements of independent Claim 26. Claim 26, as amended, recites, in part, a recessed edge for facilitating at least partial separation and re-attachment of said device. As stated hereinabove, Holden-Banks is silent as to providing a recessed edge on a label. Figure 1 of Kaufmann teaches use of a recessed edge, but Kaufmann (in col. 2, lines 40-52) fails to disclose use of a recessed edge *for* “facilitating at least partial separation and re-attachment” of the label, as recited in Claim 26. Because both Holden-Banks and Kaufmann alone or in any combination fail to disclose the use of a recessed edge for facilitating separation and re-attachment of the label, not all elements of Claim 26 are taught. In addition, no motivation exists, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine these references as such.

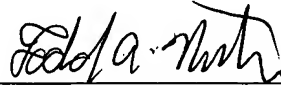
Accordingly, Applicant submits at least Claims 15 and 26 are patently distinguishable over the prior art cited. Applicant further submits that Claims 16-22, 24, and 27-31 are similarly distinguishable over the prior art cited by virtue of their ultimate dependency from patently distinct base Claims 15 and 26. Applicant further submits that Claims 23, 25 and 32 are similarly distinguishable over the prior art cited by virtue of their ultimate dependency from patently distinct base Claims 15 and 26.

Applicant submits at least Claim 39 is patently distinguishable over the prior art cited. Applicant further submits that Claims 43-47, 50 and 51 are similarly distinguishable over the prior art cited by virtue of their ultimate dependency from a patently distinct base Claim 39.

**Conclusion**

Applicant respectfully requests early and favorable action with regard to the present Application, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Todd A. Norton", is written over a horizontal line.

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